

REMARKS

I. Status of Claims

Claims 1-29 are pending in the application. Claims 3, 4, 6 9-15, 20 and 25 have been withdrawn pursuant to a restriction requirement. Thus, claims 1, 2, 5, 7, 8, 16-19, 21-24 and 26-29 are under examination and. Claims 1, 2, 5 16-19, 21-24 and 26-29 stand rejected under 35 U.S.C. §112, first paragraph (written description and enablement). Claims 16-19, 21-24 and 26 stand rejected under the second paragraph of §112. Claims 1, 5, 7, 16-18, 27 and 28 stand rejected under 35 U.S.C. §102(a) over *Bluestone et al.* (1988). Claims 1, 2, 16, 17, 19, 21, 24 and 26-29 stand rejected under §102(b) over U.S. Patent 4,722,547 (“the ‘547 patent”). Claims 1, 5, 7, 8, 16-18, 27 and 28 stand rejected under 35 U.S.C. §103 over *Bluestone et al.* and *Mezzanzanic et al.* (1988). Claims 19, 21-24, 26 and 29 stand rejected under §103 over the ‘547 patent in view of *Bluestone et al.* and *Mezzanzanica et al.*, further in view of EP 0 273 716 (“the ‘716 patent”). The specific grounds for rejection, and applicant’s response thereto, are set out in detail below.

II. Objection to the Specification

The examiner has identified a spelling error in the abstract, and mislabeling of some figures. Amendments are provided to address these issues.

III. Rejection Under 35 U.S.C. §112, First Paragraph (Written Description)

Claims 1, 2, 5, 16-19, 21-24 and 26-29 stand rejected under 35 U.S.C. §112, first paragraph as allegedly lacking an adequate written description. Applicants traverse the rejection, but in the interest of advancing the prosecution, the claims have been amended to recite the

elements of claim 7, which has not been rejected on these grounds. Therefore, it is believed that the claims as presented here find adequate written support in the specification as filed. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

IV. Rejection Under 35 U.S.C. §112, First Paragraph (Enablement)

Claims 1, 2, 5, 7, 8, 16-19, 21-24 and 26-29 stand rejected under 35 U.S.C. §112, first paragraph as allegedly lacking an enabling disclosure. Applicants traverse the rejection, but in the interest of advancing the prosecution, the claims have been amended to recite the elements of claim 7, which has not been rejected on these grounds. Therefore, it is believed that the claims as presented here find adequate enabling support in the specification as filed. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

V. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 16-19, 21-24 and 26 stand rejected under the second paragraph of §112. Specifically, antecedent basis for the term “second protein” is questioned. Applicants have amended to claim 1 to replace “compound” with “protein,” thereby obviating the rejection. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

VI. Rejections Under 35 U.S.C. §102

A. *Bluestone et al.*

Claims 1, 5, 7, 16-18, 27 and 28 stand rejected under 35 U.S.C. §102(a) over *Bluestone et al.* (1988). Applicants traverse the rejection on the merits, but are filing herewith a “Katz” declaration explaining why the non-inventor authors did not contribute to the conception of the

invention described in the reference. As such, *Bluestone et al.*(1988) is not “by another,” and does not qualify as prior art under §102(a). Reconsideration and withdrawal of the rejection is therefore respectfully requested.

B. The ‘547 Patent

Claims 1, 2, 16, 17, 19, 21, 24 and 26-29 stand rejected under §102(b) over U.S. Patent 4,722,547 (“the ‘547 patent”). Applicants traverse the rejection, but in the interest of advancing the prosecution, the claims have been amended to recite the elements of claim 7, which has not been rejected over the ‘547 patent. Therefore, it is believed that the claims as presented here are indeed novel. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

VII. Rejections Under 35 U.S.C. §103

A. Bluestone et al. and Mezzanzanic et al.

Claims 1, 5, 7, 8, 16-18, 27 and 28 stand rejected under 35 U.S.C. §103 over *Bluestone et al.* and *Mezzanzanic et al.* (1988). Applicants traverse the rejection on the merits, but as discussed above, applicants are filing herewith a “Katz” declaration explaining why the non-inventor authors did not contribute to the conception of the invention described in the reference. As such, *Bluestone et al.*(1988) is not “by another,” and does not properly citable as prior art against the instant claims. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

B. The '547 Patent, Bluestone et al., Mezzanzanica et al. and the '716 Patent

Claims 19, 21-24, 26 and 29 stand rejected under §103 over the '547 patent in view of Bluestone *et al.* and Mezzanzanica *et al.*, further in view of EP 0 273 716 ("the '716 patent"). Applicants traverse the rejection on the merits, but as discussed above, applicants are filing herewith a "Katz" declaration explaining why the non-inventor authors did not contribute to the conception of the invention described in the reference. As such, Bluestone *et al.* (1988) is not "by another," and does not properly cite as prior art against the instant claims. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

VIII. Conclusion

In light of the foregoing, applicant submits that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the examiner have any questions, comments or suggestions relating to the referenced patent application, a telephone call to the undersigned is invited.

Respectfully submitted,



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